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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,821	12/03/2001	Ilan Sela	65558/JPW	1401

7590 10/20/2003
Cooper & Dunham
1185 Avenue of the Americas
New York, NY 10036

EXAMINER

MEHTA, ASHWIN D

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 10/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/889,821	SELA ET AL.	
	Examiner	Art Unit	
	Ashwin Mehta	1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-32 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-7, 9, 11, 13, 15-19, 21-30, drawn to a first product, an expression silencing system comprising a nucleotide sequence corresponding to the T7 RNA polymerase gene which sequence carries an NLS sequence, and a T7 promoter and at least one target sequence downstream of said T7 promoter, said system capable of rendering the expression at the RNA level of a target sequence in a plant cell substantially silenced, and a first method, for the transformation of a plant with a gene-silencing system or of silencing the expression of a target sequence in the genome of a plant.

Group II, claim(s) 1-3, 5-9, 11-13, 15-19, 27-30, drawn to a second product, an expression silencing system comprising a nucleotide sequence corresponding to the T7 RNA polymerase gene which sequence carries an NLS sequence, and a T7 promoter and at least one target sequence downstream of said T7 promoter, said system capable of rendering the expression at the RNA level of a target sequence in a plant pathogen substantially silenced, and a second method, of silencing the expression of a target sequence in the genome of a plant pathogen.

Group III, claim(s) 1-3, 5, 6, 10, 11, 13, 16, 17, 19, drawn to a third product, an expression silencing system comprising a nucleotide sequence corresponding to the T7 RNA polymerase gene which sequence carries an NLS sequence, and a T7 promoter and at least one target sequence downstream of said T7 promoter, said system capable of rendering the expression at the RNA level of a target sequence in a mammalian cell substantially silenced.

Group IV, claim(s) 1-3, 5, 6, 10, 11, 13, 14, 16, 17, 19, drawn to a fourth product, an expression silencing system comprising a nucleotide sequence corresponding to the T7 RNA polymerase gene which sequence carries an NLS sequence, and a T7 promoter and at least one target sequence downstream of said T7 promoter, said system capable of rendering the expression at the RNA level of a target sequence in a mammalian pathogen substantially silenced.

Group V, claim(s) 1-3, drawn to a fifth product, an expression silencing system comprising a nucleotide sequence corresponding to the T7 RNA polymerase gene which sequence carries an NLS sequence, and a T7 promoter and at least one target sequence downstream of said T7 promoter, said system capable of rendering the expression at the RNA level of a target sequence in a bacterium substantially silenced.

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Group VI, claim(s) 1-3, drawn to a sixth product, an expression silencing system comprising a nucleotide sequence corresponding to the T7 RNA polymerase gene which sequence carries an NLS sequence, and a T7 promoter and at least one target sequence downstream of said T7 promoter, said system capable of rendering the expression at the RNA level of a target sequence in a bacterial pathogen substantially silenced.

Group VII, claim(s) 1-3, drawn to a seventh product, an expression silencing system comprising a nucleotide sequence corresponding to the T7 RNA polymerase gene which sequence carries an NLS sequence, and a T7 promoter and at least one target sequence downstream of said T7 promoter, said system capable of rendering the expression at the RNA level of a target sequence in a yeast cell substantially silenced.

Group VIII, claim(s) 1-3, drawn to an eighth product, an expression silencing system comprising a nucleotide sequence corresponding to the T7 RNA polymerase gene which sequence carries an NLS sequence, and a T7 promoter and at least one target sequence downstream of said T7 promoter, said system capable of rendering the expression at the RNA level of a target sequence in a yeast pathogen substantially silenced.

Group IX, claim(s) 20, 22-26, drawn to third method, a process for the transformation of a plant with a gene-silencing system comprising transforming plant cells with a first DNA construct comprising a nucleotide sequence corresponding to the T7 RNA polymerase, at least one plant promoter and at least one plant terminator sequence, and a second DNA construct comprising a T7 promoter, a targeting sequence downstream to said promoter, and at least one 3' non-translated terminator sequence, selecting plant cells transformed with at least one DNA construct, and hybridizing a plant with said first DNA construct with a plant transformed with said second DNA construct.

Group X, claim(s) 31 and 32, drawn to a fourth method, of identifying a nucleic acid of interest within a plant genome.

The inventions listed as Groups I-X do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the expression silencing system capable of silencing a target sequence in a plant cell of Group I is not shared with the silencing system capable of silencing a target sequence in a plant pathogen of Group II, a mammalian cell of Group III, a mammalian pathogen of Group IV, a bacterial cell of Group V, a bacterial pathogen of Group

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VI, a yeast cell of Group VII, or a yeast pathogen of Group VIII. The particular host cells of each of Groups I-VIII are not shared by each other. The expression silencing systems comprising a nucleotide sequence corresponding to the T7 RNA polymerase gene which sequence carries an NLS sequence of Groups I-VIII are not shared by the process for plant transformation with a gene-silencing system of Group IX, which does not comprise an NLS sequence. The identification of a nucleic acid of interest of the method of Group X is not shared with any of the other groups.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

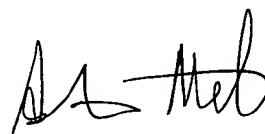
Contact Information

Any inquiry concerning this or earlier communications from the examiner should be directed to Ashwin Mehta, whose telephone number is 703-306-4540. The examiner can normally be reached on Mondays-Thursdays and alternate Fridays from 8:00 A.M to 5:30 P.M. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached at 703-306-3218. The fax phone numbers for the organization where this

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application or proceeding is assigned are 703-305-3014 and 703-872-9306 for regular communications and 703-872-9307 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

October 17, 2003

A handwritten signature in black ink, appearing to read 'Ashwin D. Mehta'.

Ashwin D. Mehta, Ph.D.
Primary Examiner
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